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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/753,270	01/08/2004	Anatoly Feygenson	225265	6572
23460	7590	12/09/2008	EXAMINER	
LEYDIG VOIT & MAYER, LTD			CASLER, TRACI	
TWO PRUDENTIAL PLAZA, SUITE 4900			ART UNIT	PAPER NUMBER
180 NORTH STETSON AVENUE				3629
CHICAGO, IL 60601-6731				
			MAIL DATE	DELIVERY MODE
			12/09/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/753,270
Filing Date: January 08, 2004
Appellant(s): FEYGENSON ET AL.

David M Airan
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 27, 2007 appealing from the Office action mailed July 27, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

US Application 11/273,459 is a divisional of the application is also currently on appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,567,784 **Bukow** **05-2003**

www.medquist.com retrieved from wayback machine(www.archive.org) any link June 8, 2003.

NEW GROUND(S) OF REJECTION

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16-32 are rejected under 35 U.S.C. 101 because the claims do not limit any process step to any specific machine/apparatus or transformation of an article. The machine or transformation test is a two-branch inquiry; an applicant may show that a process claim satisfies 101 either by showing that his claim is tied to a particular machine or by showing that his claim transforms an article. Furthermore, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. (See *In re Bilski*)

In the claims listed above, there is no machine or transformation of an article positively claims in the process steps.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. Claim21-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims are directed to the identification of an "independent individual contractor". One skilled in the art would not reasonably convey that a potential candidate for an employer would be understood to be an "independent individual contractor". Applicant fails to disclose a contractor as a candidate therefore leaving the claim limitations narrower than that of the specification.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,567,784 Bukow; Method and Apparatus for Matching Projects and Workers. Hereinafter referred to as Bukow.

4. As to claim 16 Bukow discloses:

Determining necessary tasks to be performed(C. 1 l. 33-37).

Submitting the need for someone to perform the certain tasks that are capable of being performed over the internet(C. 2 l. 60-65).

Choosing a candidate that meets the requirements of the task(C. 3 l. 34-40).

Negotiating pay for the task(C. 5 l. 63-67).

Paying the candidate the negotiated price(C. 3 l. 34-40).

5. As to claim 17 Bukow teaches the applicants having certain credentials(C. 5 l. 20-29).

6. As to claim 18 Bukow teaches indirectly determined applicant pool(C. 8 l. 22-26).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 19 and 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,567,784 Bukow as applied to claims 16-18 above, and further in view of www.medquist.com; retrieved from the wayback machine; any linkage June 8, 2003. Hereinafter referred to as Medquist.

10. As to claims 19 and 21 Bukow teaches

Determining necessary tasks to be performed(C. 1 l. 33-37).

Submitting the need for someone to perform the certain tasks that are capable of being performed over the internet(C. 2 l. 60-65).

Choosing a candidate that meets the requirements of the task(C. 3 l. 34-40).

11. However, Bukow fails to teach receiving the complete work from the applicant and paying the applicant.

12. Medquist teaches receiving the completed work at the clinic(Pg. 18 ¶B).

13. Medquist further teaches paying the applicant for the amount of work completed.(Pg. 14 ¶G). It would have been obvious to one of ordinary skill in the art to pay the user for the work completed as this is a normal practice in any business environment. If payments are being made for work done the work will cease to be complete.

14. As to claims 22-27 Bukow fails to teach the atomic unit of work being a reviewing a document for typographical error. Medquist the work being reviewing dictation with

accuracy. The examiner notes the type of atomic work that is being performed or the information it is being performed on is non-functional descriptive data. The method of identifying a qualified candidate to perform the atomic unit would be performed the same regardless of the type of work being requested.

15. As to claims 28 and 29 Bukow teaches the specific criteria requested in order to perform the task being requested.(C. 2 l. 66-67) C. 3 l. 1-2). Again, the applicant notes that the type of criteria being requested is again non-functional descriptive material. It would be an obvious variant to use different criteria needed depending on the difference in tasks needed to be completed.

16. As to Claim 30 Bukow teaches criteria as certification levels(C. 3 l. 10-12).

17. As to claims 31-32 Bukow teaches criteria a level of previous experience.

(10) Response to Argument

Rejection of Claims 21-32 under 35 USC 112 1st Paragraph

The appellant argues that its is well "established" independent contractor is and sites the definition from Black's Law Dictionary, and makes that statement that although the specification does not use the term "independent individual contractor" it "contemplates" that participants in the EWP WILL be "independent contractors".

The examiner notes the lack of written description is not given because it is not understood by what is meant by and "Independent Individual contractor" but rather that the specification does not support the narrowing of the claims to limit participants to "individual independent contractors". The examiner further notes that the appellant has

given a definition of an "independent contractor" vs. and "individual independent contractor", as claimed, which again is a narrower scope than the definition.

The appellant sites sections from the specification that teach participants being able to choose work-hours, geographic location type of work. The examiner notes this could simply be a telework program and/or flexible schedule program within a company. The appellant further points to sections that show the participants working anonymously for the employer. Nothing in the disclosure with lead one of ordinary skill in the art to know that a participant in the EWP WILL be an "individual independent contractor". The appellant intends to argue his interpretation of the disclosure as obvious to one of ordinary skill in the art. The applicant has the burden of showing that a person of skill in the art would have understood, at the time the application was filed that the description requires the limitation. Hyatt, 47 USPQ 2d @1131.

By way of the example the examiner draws attention to the Medquist reference, Medquist is a company that employees individual to do medical coding for various different health facilities. As originally claimed Medquist alone could read on Claim 21 as assigning their employees(participants) to code medical bills for certain facilities based on the facilities needs and the employees skills. As currently claimed each employee would have to be their own contractor, be their own **individual** company.

Rejection of Claims 16-18 under 35 USC 102(e) by US Patent 6,567,784

Bukow

The appellant argues that Bukow fails to teach an "atomic unit of work" and sites appellants disclosure defining an atomic unit of work as "activities that a business could not or would not for practical reasons, further subdivide."

The examiner notes that scope of appellants definition is not limited as it is not a closed definition, the appellants examples of "atomic units" are simply that, examples but do not limit or close the scope of what is encompassed by the definition.

The appellant further argues that the action is addressing limitations not claims "Determining tasks necessary to be performed." The examiner notes that tasks to be performed are what need to be done, the type of work needed to be completed. As C. 1 l. 33-37 discloses a company needed to develop a website(task) must subcontract the art work (atomic units).

The examiner draws attention to C. 2 l. 53-60 in which Bukow describes what can be considered "activities"/tasks as "proofreading, researching or some other type of activity".

Applicant claims that Bukow does not describe "breaking down" the task into several types of atomic units". The examiner notes that although the claims "determine several types" the proceeding steps simply require "at least one" type of atomic unit to be performed. Furthermore, Bukow teaches "mandatory characteristics" that are evaluated to determine if a worker and do the task(artwork).(c. 1 l. 60-67).

The appellant argues that Bukow fails to teach "negation of payment". The examiner notes that Bukow discusses in several passages. Setting a cost for what a

worker will work for and accepting what a worker submits as their cost(C. 3 l. 34-40.C. 6 Table 1 l. 1-12 C. 5 l. 63-66).

The appellant argues that "artwork" as part of developing a website is not a description of an activity that a business could not, or would not for practical reasons further subdivides. The appellant fails to provide support for why website artwork would not qualify as "atomic unit of work". Appellant argues that Bukow teaches matching the "entire project" with works. The examiner notes the project being matching in this case is the website artwork with is part of (or a divided portion) of the larger project the entire website. It appears the appellant is arguing a simply use of different terms, when appellants terms are given non-limiting open definitions.

The appellant further argues that Bukow fails to teach determining pool of candidates via "indirect message delivery process". The appellant argues that Bukow teaches only "interested" candidates can contact the project creator. The examiner notes that the system first identifies candidates that match the user skills with the project needs before passing on the match list on and indicating to a candidate that they are a match for a certain project.(C. 5 l. 30-38 and C. 8 l. 1-22).

**Rejection of Claims 19 and 21-32 under 35 USC 103(a) Bukow in view of
www.medquist.com**

The appellant argues that Bukow fials to teach "separating tasks into subparts". The examiner notes that Bukow teaches the example of website development in which the contractor must sub contract out the artwork portion of the website. This in essence is dividing the website(task) into subparts(artwork) that can be performed on an atomic

unit basis. Bukow further teaches (C. 2 l. 62-65) these subparts are can be done "freelance" which inherently is someone who provides services as needed hourly, daily as needed rather than a regular employee.

The appellant argues that Bukow fails to teach "offering to individual independent contractors in the identified group(meeting qualifications) the opportunity to perform the type of atomic units." The examiner notes this limitation is interpreted to read according to Bukow that once candidates are determined to meet the qualifications requested by the project creator the candidates are sent the project description for their review. (C. 8 l. 16-35) teaches the candidate posting work interests in art work and the system matches her with the contractor searching for a candidate to do artwork for the websites. Thus the candidate has been "Offered the opportunity" to perform a unit of work". The appellant is further Directed to Fig. 3 in which it displays the matches and past projects.

The appellant argues that the examiner has failed to establish a *prima facie* case of obviousness. The appellants cites the May 3, 2007 Memorandum from Deputy Commissioner for Patent Operations, from Margaret Focarino in which examiners are still required to at least identify " the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claims." The appellant asserts the action lacks this requirement by making a "hypothetical" combination without any explanation. The examiner notes that a hypothesis is an interpretation of a practical situation which is assumed to be true unless proven otherwise. The examiner also believes the statement made in the office action dated July 27, 2006 "It would have

been obvious to one of ordinary skill in the art to pay the user for the work completed as this is a normal practice in any business environment"(knowledge of the art) and if payment are not made for work done the work will cease to be completed(explanation). Therefore, the examiner believes the burden has been met to provide a *prima facie* case of obviousness based on the knowledge of those ordinary and common in the art of employment and payment of work and contracts.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

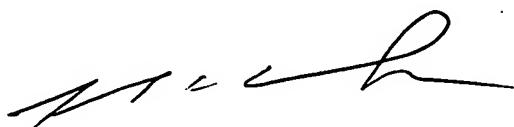
Traci L. Casler

/Traci L. Casler/

Conferees:

John G. Weiss

Vincent Millin

Handwritten signatures of John G. Weiss and Vincent Millin are placed here. The signature of John G. Weiss is a stylized 'J' and 'W'. The signature of Vincent Millin is a stylized 'V' and 'M'.

**A Technology Center Director or designee must personally approve the
new ground(s) of rejection set forth in section (9) above by signing below:**

Wynn Coggins

Director TC 3600

A handwritten signature in black ink, appearing to read "Wynn Coggins".